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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/785,783	02/16/2001	Robert A. Foster	M-9381 US	3408

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EXAMINER

GORT, ELAINE L

ART UNIT PAPER NUMBER

3627

DATE MAILED: 11/07/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/785,783

Applicant(s)

FOSTER, ROBERT A.

Examiner

Elaine Gort

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 June 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-38 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-38 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC §112 2nd Paragraph

1. The following is a quotation of the 2nd paragraph of 35 U.S.C. §112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1-38 are rejected under 35 U.S.C. §112, 2nd paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

- a. In claims 1-38, it is unclear what Applicant asserts as a transaction or contract to buy. In view of James J. White and Robert S. Summers's Uniform Commercial Code, 4th Ed., ("White & Summers") §3-8, it is the Examiner's factual determination that what constitutes an end of sale is indefinite. In other words, a standard contract requires at a minimum, a firm price and quantity. White & Summers states that when price is agreed to at a later date, the transaction has in effect not ended. Only when the price is known is the transaction actually completed. It is therefore indeterminate as to when the transaction is completed.

Claim Rejections - 35 USC §103

3. The following is a quotation of 35 U.S.C. §103(a) which forms the basis for all obviousness rejections set forth in this Office Action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-38 are rejected under 35 U.S.C. §103(a) as being unpatentable over Halbert et. al. (U.S. 6,101,484) ("Halbert") in view of Peterson et. al. (U.S. 6,324,522 B2) ("Peterson").

Halbert discloses a method/computer storage medium for pricing transactions in real-time, comprising: defining a first transaction (the purchase of a product or service) with a first production service being a component of the transaction (the service is a sub component of the featured or sold product, see C4, ~ L25-29 which states "Featured Product: Any product or product variant identified for sale through a co-op. For purposes of this application, the term 'featured product' includes any services which might be identified for sale through a co-op."); determining a count of first production service instances (determining a count of products purchased by a particular consumer); determining a billable entity for the transaction with the billable entity being at least one financial account (the customer's account number such as credit card or checking account number is on file in the system); determining a price applicable to the total of the first production service instances (the price is based upon the aggregate of all the products purchased to take advantage of volume discounting). Halbert does not directly disclose requesting a price quote.

Peterson directly discloses requesting a quote at column 27 (*i.e.* C27). Therefore it would have been obvious to a person having ordinary skill in the art at the time the invention was made to modify Halbert to include Peterson's ability to ask for a price

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quote. By including a price quote feature in Halbert, Before any of the purchasing in Halbert begins, a user may simply ask the system for an initial price quote to get a minimum starting point of where the price begins. By getting an initial price quote, the customer is in a better position to evaluate the benefits of joining Halbert's system.

5. For types purchasing contracts, see also reference Purchasing & Supply Management, Text and Cases, 6th Ed. by Dobler et. al. ("Dobler"), pp 86-89.

6. For due process purposes and because Applicant has not objectively indicated and redefined claim limitation(s) to have meanings other than their ordinary and accustomed meanings, the Examiner confirms that Applicant has decided not to be his own lexicographer. To support this position, the Examiner again notes the following factual findings as first discussed in the previous Office Actions.¹ First, the Examiner has again carefully reviewed the specification and prosecution history and can not locate any lexicographic definition(s). Second, the Examiner finds that not only has Applicant not pointed to definitional statements in his specification or prosecution history, Applicant has also not pointed to a term or terms in a claim with which to draw in those statements² with the required clarity, deliberateness, and precision.³ Third,

¹ See the "First Non Final Office Action" mailed March 30, 2004, Paragraph No. 12; the "First Final Office Action" mailed October 14, 2004, Paragraph No. 18.

² "In order to overcome this heavy presumption in favor of the ordinary meaning of claim language, it is clear that a party wishing to use statements in the written description to confine or otherwise affect a patent's scope must, *at the very least*, point to a term or terms in the claim with which to draw in those statements. [Emphasis added.]" *Johnson Worldwide Assocs. v. Zebco Corp.*, 175 F.3d 985, 989, 50 USPQ2d 1607, 1610 (Fed. Cir. 1999).

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after receiving express notice of the Examiner's position that lexicography is *not* invoked,⁴ Applicant's three (3) responses have not pointed out the "supposed errors" in the Examiner's position regarding lexicography invocation in accordance with 37 C.F.R. §1.111(b) (*i.e.* Applicant did not argue lexicography was invoked). Forth and to be sure of Applicant's intent, the Examiner also notes that Applicant has declined the Examiner's express invitation⁵ to be his own lexicographer. Finally, after receiving express notice of the preceding factual findings and conclusions, Applicant's latest response again fails to point out the supposed errors in the Examiner's position regarding lexicography invocation in accordance with 37 C.F.R. §1.111(b). Moreover, Applicant's latest response—while fully considered by the Examiner—has not changed the Examiner's reasonable conclusion that Applicant has decided not to be his own lexicographer. Therefore (and unless expressly noted otherwise by the Examiner), the heavy presumption in favor of the ordinary and accustomed meaning for claim terminology is again confirmed. Accordingly, the claims continue to be interpreted with

³ "The patentee's lexicography must, of course, appear 'with reasonable clarity, deliberateness, and precision' before it can affect the claim." *Renishaw PLC v. Marposs Societa' per Azioni*, 158 F.3d 1243, 1249, 48 USPQ2d 1117, 1121 (Fed. Cir. 1998) citing *In re Paulsen*, 30 F.3d 1475, 1480, 31 USPQ2d 1671, 1674 (Fed. Cir. 1994).

⁴ See Note 1.

⁵ See *e.g. Fuji Photo Film Co. v. ITC*, 386 F.3d 1095, 72 USPQ2d 1769, 1773 (Fed. Cir. 2004) (noting that applicants' failure to correct the examiner's characterization of an element of claim interpretation is nevertheless an indication of how a claim should be interpreted since applicant declined the examiner's express invitation to correct a possible error in claim interpretation: "applicant's attention was called to the examiner's interpretation of [how the element was interpreted by the examiner, and] applicant was invited to correct the examiner's interpretation—an invitation the applicant did not accept."

their "broadest reasonable interpretation," *In re Morris*, 127 F.3d 1048, 1054, 44 USPQ2d 1023, 1027 (Fed. Cir. 1997), and the Examiner continues to rely heavily and extensively on this interpretation.⁶

Response to Arguments

7. Applicant's arguments filed 6/26/06 have been fully considered but they are not persuasive.

Applicant has argued that the meaning the Examiner has ascribed to the term "transaction" is totally irrelevant as the Applicant's Specification defines the meaning of the term. Applicant states the Specification provides on page 4 lines 31-33 a definition for "Transaction". Examiner points out that on page 4 of the specification there is no definition provided, but only a list of files. Examiner further points out that the presented definition is not a lexographic definition as per MPEP 2111.01. MPEP 2111.01 states that while the claims of issued patents are interpreted in light of the specification, prosecution, history, prior art and other claims, this is not the mode of claim interpretation to be applied during examination, that words of the claim must be given their plain meaning unless applicant has provided a **clear** definition in the specification. The definition of "transaction" presented in the Applicant's Amendment is unclear as it states that a transaction refers to a product or service that is offered for consumption, but does not state what is actually being claimed as a "transaction".

⁶ See 37 C.F.R. §1.104(c)(3) which states in part: "the examiner may rely upon admissions by applicant . . . as to *any matter* affecting patentability [Emphasis added.]"

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Webster defines a transaction to include an **exchange** of goods, services and funds. Is the Applicant merely claiming the offering of goods or services and no actual exchange? It remains unclear if the Applicant is claiming an "offer" or an actual "transaction" where an exchange occurs.

Applicant has argued that "Halbert's col. 4, lines 25-29 discloses or suggests none of the "determining" steps in Claims 1, 9 and 26, each of which reciting a billing cycle, production service instances and a pricing method". Examiner notes that the rejection is based on the Halbert reference, not just col. 4, lines 25-29. Examiner contends that Halbert discloses all the determining steps. For example the determining of a first production service (C4, lines 25-29 disclose where the featured product includes services which is inherently determined when the seller offers the services for sale via the system), the first production service being a component of the transaction (for example in the sale of a service the service is a component of the transaction. Examiner, for example, construes this to include services such as the sale of a service warranty contract.);

Determining a count of first production service instances representing the first production service in the transaction (Examiner construes the count to be a count of the number of services which is being purchased. In the Example provided above on the sale of service warranty contracts this would include the number of service warranty contracts being purchased); determining a billable entity for the transaction (such as the customer's credit card number, for example see column 3, lines 7+), the billable entity comprising one or more related accounts, wherein the one or more related accounts

includes the first account (if there is only one account then the "related accounts" comprise the credit card account which includes the first account which is also the credit card account); determining a total of the first production service instances associated with the one or more related accounts during the billing cycle up to the first instance in time, the total including the count of the first production service instances in the transaction (Halbert discloses, for example in the abstract, that the sale has a defined start time and end time which the Examiner is construing to be a "billing cycle". When the sale ends a total of the number of services sold is inherently used in order to calculate the amount to be charged to the buyer's credit card account in order to obtain adequate funds. For example if only one service is purchased, then only one is charged. If two are purchases the amount per service is multiplied by 2 to get the total due prior to charging the credit card account.); determining a price applicable to the total of the first production service instances based on a pricing method (Halbert discloses the determining of a price based on a pricing method, for example in the abstract it discusses how the system uses a starting price and a product cost curve. In Halbert the cost is reduced as the number of goods/services purchased increases to take advantage of group buying discounting.)

Conclusion

8. THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Elaine Gort whose telephone number is 571/272-6781. The examiner can normally be reached on Monday and Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alexander Kalinowski can be reached on 571/272-6771. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

A handwritten signature in black ink, appearing to read 'Elaine Gort', with a stylized, flowing script.

Elaine Gort
Primary Examiner
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November 6, 2006